

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	§	
Springer, David S. et al	§	
	§	Group Art Unit: 3622
Serial No. 09/313,436	§	
	§	
Filed: May 17, 1999	§	
	§	Examiner: Khanh H. Le
For: METHOD AND APPARATUS FOR	§	
TRACKING BANNER ADVERTISING	§	

**REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41**

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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This Paper is submitted pursuant to 37 CFR §41.41 as a Reply Brief to the Examiner's Answer, mailed on July 17, 2006.

**1. Background and Introduction**

The rejections in this application are based on three references: (1) U.S. Patent 6,119,098 (Guyot); (2) U.S. Patent 6,285,983 (Jenkins); and (3) U.S. Patent 5,848,397 Marsh et al (Marsh). In the Appeal Brief, Applicants argue that:

"The claimed invention provides a unique identifier imbedded in a system component by the manufacturer associated with a database including information specific to the user of the system provided by the manufacturer.

This is uniquely unlike the Guyot system which provides advertisements to subscribers based on a personal profile provided by that subscriber.

The unique identifier of the present invention is imbedded in a system hardware or software component during manufacture, which is uniquely unlike the cookie file installed on a hard disk drive of a browsing consumer in *Jenkins*.

There is no supporting reference which teaches or suggests tracking information provided to a computer system from an advertisement database accessed by a computer manufacturer to provide discounts to users, based on a user receiving a predetermined number of advertisements that are tracked in a time period and associated with an identifier, as claimed, nor is there a teaching or suggestion of a unique identifier imbedded in a system component by the manufacturer associated with a database including information specific to the user of the system provided by the manufacturer.

Therefore, it is impossible to render the subject matter of the claims as a whole obvious based on a single reference or any combination of the references, and the above explicit terms of the statute cannot be met."

In response to the Applicant's argument, the Examiner stated that (copied verbatim including grammatical and/or typographical errors):

"As stated during prosecution, Guyot does not specifically disclose the identifier is stored on a (the user's) hard drive (claims 8 and 30) or is imbedded in the user computer hardware (claim 1). However, in the analogous advertising art, Jenkins discloses that *"As is known in the art, cookie files may be installed by a web site server on the computer hard disk drive of a browsing consumer. Cookies typically include information indicating that the browser has visited that website"* (see at least Jenkins, col. 1 lines 18-40; col. 4 lines 36-61) to monitor her online activities and uniquely identify the user. (The "information indicating that the browser has visited that website" mentioned by Jenkins is a unique identifier to identify, the browsing user, as is well-known by Jenkins' application time. See e.g. Douglass US 6249795 B1, col.7 lines 48-52, herein provided as prior art support for this well known fact).

As stated during prosecution it would have been obvious to one skilled in the art at the time the invention was made to install the cookie file on the user hard drive to implement the

user identification method of Guyot because such cookie implementation technique is well-known (typical) as stated in Jenkins (col. 1 lines 37-40).

At page 12 of the Brief, Appellants further argue undesirability of the combination of Guyot and Jenkins, citing some well-known problems of cookies. The Examiner notes that the 3 defects of cookies argued, to wit, inability of cookies for automatic identification of the user to enable revenue sharing, automatic correlating of user preferences for targeted advertising, and lack of security, are first undocumented, and then address features that are not claimed, and therefore are irrelevant.

Further, for example, as to cookies used of automatic correlating of user preferences for targeted advertising, Jenkins clearly show used of cookies to derive preferences (profiles) for targeted offers.

Guyot teaches identifying users for monitoring of ads exposure, delivery of targeted ads and compensation based on viewing ads. Jenkins adds to Guyot the specific use of cookies for user identification in the same context of monitoring online behavior for better ads/offers targeting. Jenkins clearly suggests the need and the success for such user identification at (col. 4 lines 34-61) in the collection of consumer behavior data, by different sources, one of which is web browsing history, by using cookies files.

Thus as stated earlier, it would have been obvious to one skilled in the art at the time the invention was made to install the cookie file on the user hard drive to implement the user identification method of Guyot because such cookie implementation technique is well-known (typical) as stated in Jenkins (col. 1 lines 37-40)."

## **2. Argument**

As the Applicants previously pointed out:

"The rejection also admits that "Guyot does not specifically disclose the identifier is stored on a (the user's) hard drive (claims 8 and 30) or is imbedded in the user computer hardware (claim 1) and argues that in the analogous advertising art, Jenkins discloses that "As is known in the art, cookie files may be installed by a web site server on the computer hard disk drive of a browsing consumer" (see at least col. 1, lines 18-39).

The use of cookies presents some well-known problems as follows:

1. Cookies do not automatically identify the client computer's owner to enable advertising revenue sharing.
2. Cookies do not automatically allow any correlation between the computer's owner and individual preferences for targeted advertising.
3. Cookies are lacking in desirable security features because they can be easily altered, deleted, disabled or copied to multiple computers.

Thus, neither of these references provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103(a) rejection of the claims."

The Examiner uses as justification for combining the references, the following:

"The motivation is adequate, the *prima facie* case is clearly made.

Lastly, it is noted law of obviousness does not require that references be combined for reasons contemplated by inventor, but only looks to whether some motivation or suggestion to combine references is provided by prior art taken as a whole. *In re Beattie*, 24 USPQ2d 1040 (CA FC 1992). "

Applicants submit that the well know problems of using cookies would clearly not teach or suggest the desirability of the combination to one skilled in the art.

### 3. **Legal Precedent**

As the PTO recognizes in MPEP §2142:

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

The USPTO clearly cannot establish a *prima facie* case of obviousness in connection with the amended claims for the following reasons.

35 U.S.C. §103(a) provides that:

[a] patent may not be obtained ... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains ... (emphasis added)

Thus, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. However, the references, alone, or in combination, do not teach the invention as a whole.

Therefore, it is impossible to render the subject matter of the claims as a whole obvious based on a single reference or any combination of the references, and the above explicit terms of the statute cannot be met. As a result, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and a rejection under 35 U.S.C. §103(a) is not applicable.

There is still another compelling, and mutually exclusive, reason why the references cannot be combined and applied to reject the claims under 35 U.S.C. §103(a).

The PTO also provides in MPEP §2142:

[T]he Examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the Examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. ...[I]mpermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Here, the references do not teach, or even suggest, the desirability of the combination.

Thus, neither of these references provides any incentive or motivation supporting the desirability of the combination. Therefore, there is simply no basis in the art for combining the references to support a 35 U.S.C. §103(a) rejection of the claims.

In this context, the MPEP further provides at §2143.01:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. (emphasis in original)

In the above context, the courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. In the present case it is clear that the USPTO's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to the claims. Therefore, for this mutually exclusive reason, the USPTO's burden of factually supporting a *prima facie* case of obviousness clearly cannot be met with respect to the claims, and the rejection under 35 U.S.C. §103(a) is not applicable.

4. **Conclusion**

Therefore, the Applicants would have no motivation to use the cookies of Jenkins given their acknowledged well-known shortcomings, and as such, a *prima facie* case cannot be made.

In view of all of the above, the allowance of claims 1, 4-6, 8-9 and 26-31 is respectfully requested.

Respectfully submitted,

  
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